



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,368	02/10/2004	Edward J. Stashluk JR.	067439.0161	9915
5073	7590	12/24/2008	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			NGUYEN, THUY-VI THI	
3689		ART UNIT		PAPER NUMBER
NOTIFICATION DATE		DELIVERY MODE		
12/24/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail1@bakerbotts.com
glenda.orrantia@bakerbotts.com

Office Action Summary	Application No.	Applicant(s)	
	10/775,368	STASHLUK ET AL.	
	Examiner	Art Unit	
	THUY VI NGUYEN	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 September 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-32 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/12/08, 05/30/08</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on September 12, 2008, wherein:

Claims 1, 14, and 28 have been amended;

Claims 1-32 are currently pending;

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 14-27, 28-32** are rejected under 35 U.S.C. 101 because the claim invention is directed to non-statutory subject matter, specifically directed towards computer programs (program operable to) representing computer listings per se. Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer

element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 28-29, 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser et al. (US 6,536,659) in view of Meyer et al (US 2002/0077976)

As for claim 28, Hauser discloses a computer product for providing merchandise return labels for enabling a customer to ship a package containing one or more items previously acquired from a merchant during a unique transaction, comprising programming operable to:

a) access item data representing at least one detail about the item [...*transmit the return merchandise data*; abstract; col.2, lines 11-13];

- b) access transaction data representing at least one detail about the transaction associated with the item [...*data identify the merchant and the merchandise purchased by customer*; col. 2, lines 13-16; col. 4, lines 9-15];
- c) correlate the item data and transaction data with a set of stored business rules to determine coding to be printed on a shipping label
 - {see figures 1, 3-5; disclose the correlating data with rules to generate the shipping label with a barcode};
 - wherein the set of stored business rules specify how packages are to be shipped and represent guidelines for determining a selected shipping carrier, a shipping destination or shipping rate {see figures 1-2 shows the correlate the item and data transaction and figure 2 shows *selected from the group of shipping destination (i.e. retailer, donate to charity, salvage*; col. 6, lines 50-65];
- d) generate a machine readable code for the return shipping label [...*label (52) includes the address for returns (shipping origin) and a bar code to identify the merchant and merchandise being returned* (identification of the transaction); *abstract*; col. 4, lines 1-30; col. 6, lines 21-27; and figures 2 and 6]; and
 - e) format the return label, such that the return label contains the machine readable code and complies with shipping label specifications of a carrier
 - [...*return label having a machine readable code (52) figure 2; and is applied in the package to ship via USP or shipper*; col. 4, lines 16-30; figure 1, step 18-20].

HAUSER ET AL discloses the generation of the machine readable code (bar code) including returning information and the merchant information on or with the shipping label {see col. 4, lines 1-35}

HAUSER ET AL fairly teaches the claimed invention except for wherein the machine readable code is generated/correlated from the item data, transaction data, customer data, package data with a set of stored business rules.

MEYER ET AL is cited to teach the generation of the machine readable code (bar code) wherein the machine readable code is generated/correlated from the customer data and the biller/service provider data and printed the code on the mailing label (invoice or payment invoice) for the benefit of permitting a 3rd party to scan the bar code and based on the identifying data of the bar code, to effect a specific task automatically or more efficiently or in a pre-determined manner for a certain party/entity involved in the transaction or service, i.e. to effect a payment to the biller in a predetermined amount {see abstract; pars. 0030-0031; 0051; figures 1, 6-8}. It would have obvious to modify the teachings of HAUSER ET AL by modifying the generation of the machine readable code whereby the code is generated/correlated from the customer's data the biller/service provider data and printed the code on the mailing label (invoice or payment invoice) to permit a 3rd party to scan the bar code and based on the identifying data of the bar code, to effect a specific task automatically or more efficiently or in a pre-determined manner for a certain party/entity involved in the transaction or service, i.e. to effect a payment to the biller in a predetermined amount {see abstract}. The inclusion of other customer's data such as transaction data is inherently included or

would have been obvious to include other relevant customer data in the code to allow it to have more functions or information if desired.

Note: for convenience, letters (a)-(e) are added to the beginning of each step.

As for claim 29, Hauser discloses wherein the programming is further operable to access customer data representing at least one detail about a customer associated with the transaction, to further correlate customer data with the business rules [...*business rules such as sorting the merchandise, verify contents against database, disposition to merchandise; figure 2*].

As for claim 31, Hauser discloses wherein the shipping parameters further may comprise choice of carrier [figure 2].

As for claim 32, Hauser discloses wherein the shipping parameters further may comprise package disposition [figure 2].

6. Claims 1-27, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser et al. (US 6,536,659) in view of Holtz et al (2004/0128265) and further in view of Meyer et al.

As for claim 1, Hauser discloses a computer-implemented method of providing merchandise return labels for enabling a customer to ship a package containing one or more items previously acquired from a merchant during a unique transaction, comprising the steps of:

a) accessing item data representing at least one detail about the item [...*transmit the return merchandise data; abstract; col.2, lines 11-13*];

- b) accessing transaction data representing at least one detail about the transaction associated with the item [...*data identify the merchant and the merchandise purchased by customer*; col. 2, lines 13-16; col. 4, lines 9-15];
- c) accessing customer data representing at least one detail about a customer associated with the transaction [...*customer contact information; merchandise purchase by customer*; col. 2, lines 13-17; col. 4, lines 9-15];
- e) correlating the item data, transaction data, customer data, with a set of stored business rules to determine coding to be printed on a return shipping label {see figures 1, 3-5; disclose the correlating data with rules to generate the shipping label with a barcode};
 - wherein the set of stored business rules represent guidelines for determining choice of carrier, shipping destination, shipping rate, or package disposition {see figures 1-2 shows the correlate the item and data transaction and figure 2 shows *selected from the group of shipping destination (i.e. retailer, donate to charity, salvage; col. 6, lines 50-65]*;
- f) generating a machine readable code for the return shipping label [...*label (52) includes the address for returns (shipping origin) and a bar code to identify the merchant and merchandise being returned (identification of the transaction); abstract; col. 4, lines 1-30; col. 6, lines 21-27; and figures 2 and 6*]; and
- g) formatting the return label, such that the return shipping label contains the machine readable code and complies with shipping label specifications of a carrier

[...return label having a machine readable code (52) figure 2; and is applied in the package to ship via USP or shipper; col. 4, lines 16-30; figure 1, step 18-20].

HAUSER ET AL fairly teaches the claimed invention except for information about the package data/information representing at least one detail about the package in which the item is expected to be shipped (step d).

In the similar process for returning the merchandise, HOLTZ discloses accessing package data representing at least one detail about the package in which the item is expected to be shipped [...i.e. *weight package data; package's number; package's zip code; package image*; par. 0014, par. 0016 and figure 2] .

Therefore, it would have been obvious to one of ordinary skill in the art at to provide HAUSER ET AL with the process of returning the merchandise having the return labels for enabling a customer to ship a package to include the method of accessing the package data as taught by HOLTZ ET AL in order to improve the process for returning the merchandise.

HAUSER ET AL/HOLTZ fairly teach the claimed invention except for wherein the machine readable code is generated/correlated from the item data, transaction data, customer data, package data with a set of stored business rules.

MEYER ET AL is cited to teach the generation of the machine readable code (bar code) wherein the machine readable code is generated/correlated from the customer data and the biller/service provider data and printed the code on the mailing label (invoice or payment invoice) for the benefit of permitting a 3rd party to scan the bar code and based on the identifying data of the bar code, to effect a specific task

automatically or more efficiently or in a pre-determined manner for a certain party/entity involved in the transaction or service, i.e. to effect a payment to the biller in a predetermined amount {see abstract; pars. 0030-0031; 0051; figures 1, 6-8}. It would have obvious to modify the teachings of HAUSER ET AL/HOLTZ by modifying the generation of the machine readable code whereby the code is generated/correlated from the customer's data the biller/service provider data and printed the code on the mailing label (invoice or payment invoice) to permit a 3rd party to scan the bar code and based on the identifying data of the bar code, to effect a specific task automatically or more efficiently or in a pre-determined manner for a certain party/entity involved in the transaction or service, i.e. to effect a payment to the biller in a predetermined amount {see abstract}. The inclusion of other customer's data such as transaction data is inherently included or would have been obvious to include other relevant customer data in the code to allow it to have more functions or information if desired.

As for claim 2, Hauser discloses the item data identifies an item type [...*different code is associate to each type of merchandise*; col. 8, lines 23-30].

As for claim 3, Hauser discloses the item data identifies an item value [...*value of the merchandise*; col. 2, lines 53-56].

As for claim 4, Hauser discloses transaction data is a transaction identifier [...abstract; col. 4, lines 9-15].

As for claim 5, Hauser discloses transaction data is a transaction date [col. 8, lines 59-62].

As for claim 6, Hauser discloses the customer data represents a shipping origin [figures 1-2].

As for claim 7, Hauser discloses the customer data represents customer preferences [...*data from customer request for returning merchandise*; col. 4, lines 9-15].

As for claim 8, Hauser discloses customer data identifies a payee of shipping costs [...providing a prepaid shipping label (206) from merchant (202); figures 4 – 5].

As for claim 9, Holtz discloses the package data represents package weight [par. 0016].

As for claim 10, Holtz discloses the package data represents package size [par. 0062; figure 9].

Furthermore, it appears that some of the limitations in the dependent claims are non-functional descriptive material.

As for claim 11, Hauser discloses accessing shipping rate data [...prepaid shipping; figure 5].

As for claim 12, Hauser discloses accessing carrier center location data [figures 2-3].

As for claim 13, Hauser discloses the carrier center location data represents bulk mail center data [figures 2-3].

As for independent claim 14, basically has the same limitation as the rejected independent claim 1 above, it is rejected for the same reason sets forth the independent claim 1 above.

As for claim 15, Hauser discloses access at least one of the group of item data, customer data, transaction data, or product data, via a remote data communications link [figures 3 and 5].

As for claim 16, Hauser discloses further operable to access shipping rate data [...prepaid shipping; figure 5].

As for claim 17, Hauser discloses accessing carrier center location data [figures 2-3].

As for claim 18, Hauser discloses the carrier center location data represents bulk mail center data [figures 2-3].

As for claim 19, Hauser discloses wherein the item data identifies an item type [...*different code is associate to each type of merchandise*; col. 8, lines 23-30].

As for claim 20, Hauser discloses wherein the item data identifies an item value [...*value of the merchandise*; col. 2, lines 53-56].

As for claim 21, Hauser discloses wherein the transaction data is a transaction identifier [...*abstract*; col. 4, lines 9-15].

As for claim 22, Hauser discloses wherein the transaction data is a transaction date [col. 8, lines 59-62]...

As for claim 23, Hauser discloses wherein the customer data represents a shipping origin [figures 1-2].

As for claim 24, Hauser discloses wherein the customer data represents customer preferences [...*data from customer request for returning merchandise*; col. 4, lines 9-15].

As for claim 25, Hauser discloses wherein the customer data identifies a payee of shipping costs [...providing a prepaid shipping label (206) from merchant (202); figures 4 – 5].

As for claim 26, Holtz discloses wherein the package data represents package weight [par. 0016].

As for claim 27, Holtz discloses wherein the package data represents package size [par. 0062; figure 9].

As for claim 30, the teaching of Hauser is indicated above, Holtz discloses wherein the programming is further operable to access package data representing at least one detail about the package in which the item is expected to be shipped, and to further correlate package data with the business rules [...i.e. *weight package data; package's number; package's zip code; package image*; par. 0014, par. 0016 and figures 2 -5].

Therefore, it would have been obvious to one of ordinary skill in the art at to provide Hauser with the process of returning the merchandise having the return labels for enabling a customer to ship a package to include the method of accessing the package data as taught by Holtz in order to improve the process for returning the merchandise.

Response to Arguments

Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection. As for claim 1, Applicant stated that

HOLTZ ET AL does not teach the accessing package data representing at least one detail about the package in which the item is expected to be shipped. The Examiner respectfully disagrees in view of the new reference as cited above. HOLTZ disclose the process for returning the merchandise including the information about the package i.e. *weight package data; package's number; package's zip code; package image;* par. 0014, par. 0016 and figure 2] and wherein the worker have to scan one or more bar codes of the package into the data collection and tracking system above as shown on [0013]. Therefore, it would have been obvious to one of ordinary skill in the art at to provide HAUSER ET AL with the process of returning the merchandise having the return labels for enabling a customer to ship a package to include the method of accessing the package data as taught by HOLTZ ET AL in order to improve the process for returning the merchandise. For the reason above, the combination of HAUSER ET AL/HOLTZ ET AL teach “accessing package data representing at least one detail about the package in which the item is expected to be shipped”.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information As for the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689

Application/Control Number: 10/775,368
Art Unit: 3689

Page 16